

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

a steering tube clamping portion connected to the second end of said body portion and having a tubular shape defining a steering tube receiving passageway therethrough, said steering tube clamping portion also having a clamp receiving passageway therein transverse to the steering tube receiving passageway and in communication therewith;

DS
cont
a steering tube clamp in the clamp receiving passageway and comprising

a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, each clamp member also having at least one fastener receiving passageway therein canted at a predetermined angle from parallel to an axis of the imaginary cylinder, and

at least one fastener extending between corresponding fastener receiving passageways of said pair of clamp members for urging said clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

REMARKS

The Applicants thank the Examiner for the thorough examination of the present application, and for the courtesy extended during the in-person interview of September 19, 2002. By this amendment, independent Claims 1, 17, 24 and 33 have been amended to more clearly define the present invention. Dependent Claim 28 has been amended for consistency. Claims 1-76 remain pending in the application with Claims 1-6, 8-10, 12, 13, 15, 17-

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

22, 24-31 and 33-38 being directed to the elected species.
Reconsideration of the rejections is requested.

I. The Claim Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner again rejected Claims 8, 9, 19, 28, and 33-38 as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. More particularly, the Examiner alleges that "the specification does not provide adequately or describe in such a clear and concise way as to how the clamp is moved in a confined and tight clamp receiving passageway as shown in FIGS. 2 and 13".

Applicants emphasize that neither the claims nor the specification recite a "confined and tight clamp receiving passageway" as alleged by the Examiner. Indeed, the specification and drawings specifically disclose that the steering tube clamp **40**, with canted fastener receiving passageways **42b** and **42c** (e.g. as illustrated in FIGs. 10, 11, 14A and 14B), is accommodated in the clamp receiving passageway **36** as can be clearly seen in FIGs. 1 and 2. Moreover, the specification sets forth (pages 15 and 16)

As shown in FIG. 14A, the steering tube clamp **40** illustratively includes a set of fastener receiving passageways **42b**, **42c** which are canted at a predetermined angle **D** from parallel to the axis **45** of the imaginary cylinder. ...For example, the predetermined angle **D** may be in a range of about one-half to five degrees and, more preferably about one to three degrees.

Accordingly, the specification describes the steering tube clamp **40**, with fastener receiving passageways **42b** and **42c** canted at an angle, e.g. about one to three degrees, accommodated

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

in the clamp receiving passageway **36**, and with fasteners/bolts **46a** and **46b** engaged in the fastener receiving passageways.

The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention; but, detailed procedures for making and using the invention are not necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention.

As the Examiner should be aware, the standard for determining whether the specification meets the enablement requirement is that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In other words, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure coupled with information known in the art without undue experimentation.

As discussed in MPEP §2164, to make an enablement rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. A specification disclosure which contains a teaching of the manner of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. It is incumbent upon the Examiner, whenever an enablement rejection is made, to explain why he doubts the truth or accuracy of any statement in the supporting disclosure and to back up assertions of his own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for Applicants to go to the trouble and expense of supporting the presumptively accurate disclosure. See *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

The Examiner's assertion that "it would be almost impossible to engage the second fastener receiving passageway 42c without breaking the passageway 36 or the clamp members 40" is made without any acceptable evidence or reasoning which is inconsistent with the teachings of the present specification.

Accordingly, Applicants maintain that the specification describes the the subject matter of the above referenced claims in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the claimed invention, without any undue experimentation.

II. The Double Patenting Rejection Is Improper

The Examiner again provisionally rejected Claims 1-3, 10, 12, 13, 15, 17, and 20-22 under the doctrine of obviousness-type double patenting over Claims 1-27 of co-pending Patent Application Serial No. 09/658,509 in combination with the Lai patent. Applicants again point out that the present application

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

and the co-pending patent application are directed to completely different aspects of the bicycle stem.

The claims of the present application are directed to a bicycle stem including the patentably distinct details of a steering tube clamping portion. Claims 1-27 of the above-referenced co-pending application, however, are directed to a bicycle stem including the patentably distinct details of the handlebar clamping portion. The handlebar clamping portion is located at the opposite end of the stem body from the steering tube clamping portion, and is used to clamp a completely different bicycle component than the steering tube clamping portion of the present application. For at least these reasons, Applicants maintain that the present claims are directed to patentably distinct aspects of the bicycle stem and that there will exist no improper timewise extension of the right to exclude. Therefore the double patenting rejection is improper and should be withdrawn.

Additionally, independent Claims 1 and 17 have been amended to recite that respective outer surface portions of the clamp members define the imaginary cylinder and a recess therein for the steering tube, with each clamp member also having at least one fastener receiving passageway therein offset a predetermined distance from an axis of the cylinder. The claims of the co-pending application do not recite such a feature. Also, the Lai patent does not disclose or teach such a feature, as will be discussed in more detail below with respect to the rejections under 35 U.S.C. §102 and §103. For these additional reasons, the double patenting rejection should be properly withdrawn.

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

III. The Invention

The invention is directed to a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube. The bicycle stem includes a steering tube clamp in a clamp receiving passageway. The steering tube clamp comprises a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube. Each clamp member also has one or more fastener receiving passageways therein that are offset a predetermined distance from an axis of the cylinder. The steering tube clamp also comprises one or more fasteners extending between corresponding fastener receiving passageways of the pair of clamp members for urging the clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube. Additionally, or alternatively, the fastener receiving passageway may be canted at a predetermined angle from parallel to the axis of the cylinder.

IV. The Claims Are Patentable

Claims 1-6, 10, 12, 13, 15, 17, 18, 20-22, 24-27 and 29-31 were rejected in view of Lai (U.S. 5,509,328) taken alone or in combination with Roddy (U.S. 5,881,606) for the reasons set forth on pages 5-12 of the Office Action. Applicants contend that Claims 1-6, 10, 12, 13, 15, 17, 18, 20-22, 24-27 and 29-31 clearly define over the cited references, and in view of the following remarks, favorable reconsideration of the rejections under 35 U.S.C. §102 and §103 is requested.

Independent Claims 1 and 17 have been amended to recite a steering tube clamp in the clamp receiving passageway and

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

comprising a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube. Furthermore, each clamp member also has at least one fastener receiving passageway therein offset a predetermined distance from an axis of the cylinder. Similarly, independent Claim 24 includes a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, with each clamp member having a plurality of fastener receiving passageways therein offset a predetermined distance from an axis of the cylinder.

The claimed combinations of features are not fairly taught or suggested in the cited references and patentably define over the cited references.

The Examiner has relied on the Lai patent as disclosing a bicycle stem having a steering tube clamp that includes a pair of clamp members having at least one fastener receiving passageway therein offset a predetermined distance from an axis defined by an imaginary cylinder defined by portions of the clamp members. As discussed in the Office Action and during the in-person interview, the Examiner is interpreting the recitation of "an imaginary cylinder" defined by portions of the clamp members, as any cylinder imagined by the Examiner in the device of Lai that is not coaxial with the passageway. However, as noted above, the independent claims have been amended to more clearly preclude such an interpretation. Specifically, the claims now recite that outer surface portions of the clamp members define the imaginary cylinder, while the clamp members include at least one fastener

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

receiving passageway therein offset a predetermined distance from an axis of the cylinder.

As illustrated in FIG. 6 of the Lai patent, the fastener receiving passageway 86 passes directly along the axis of the cylinder defined by the outer surface portions of the clamp members. Applicants assert that the fastener receiving passageways of the Lai patent are not offset from the axis, and that independent Claims 1, 17 and 24 define over the Lai patent.

The Examiner has relied on the Roddy patent as allegedly showing a handlebar clamping portion and a steering tube clamping portion being integrally formed as a monolithic unit. However, nothing in the Roddy patent makes up for the deficiencies pointed out above with respect to the Lai patent.

There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicants maintain that the cited references do not disclose or fairly suggest the invention as set forth in Claims 1, 17 and 24. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejections under 35 U.S.C. §102 and §103 should be withdrawn.

It is submitted that the independent claims are patentable over the prior art. In view of the patentability of the independent claims, it is submitted that their dependent claims, which recite yet further distinguishing features are also patentable over the cited references for at least the reasons set forth above. Accordingly, these dependent claims require no further discussion herein.

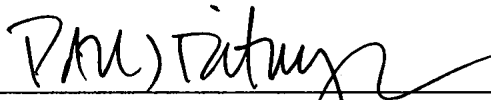
In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

V. CONCLUSION

In view of the arguments provided above, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. If any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version With Markings to Show Changes Made.**"

Respectfully submitted,



PAUL J. DITMYER
Reg. No. 40,455
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
Telephone: 407/841-2330
Fax: 407/841-2343
Attorney for Applicants



In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000
_____ /

Version With Markings to Show Changes Made

In the Claims:

The claims have been amended as follows.

1. (Amended) A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:

a body portion having opposing first and second ends;
a handlebar clamping portion connected to the first end of said body portion;

a steering tube clamping portion connected to the second end of said body portion and having a tubular shape defining a steering tube receiving passageway therethrough, said steering tube clamping portion also having a clamp receiving passageway therein transverse to the steering tube receiving passageway and in communication therewith;

a steering tube clamp in the clamp receiving passageway and comprising

a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, each clamp member also having at least one fastener receiving passageway therein offset a predetermined distance from an axis defined by the imaginary cylinder, and

at least one fastener extending between corresponding fastener receiving passageways of said pair of clamp members for urging said clamp members

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

17. (Amended) A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:

- a body portion having opposing first and second ends;
- a handlebar clamping portion connected to the first end of said body portion;

- a steering tube clamping portion connected to the second end of said body portion and having a tubular shape defining a steering tube receiving passageway therethrough, said steering tube clamping portion also having a clamp receiving passageway therein transverse to the steering tube receiving passageway and in communication therewith;

- a steering tube clamp in the clamp receiving passageway and comprising

- a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, each clamp member also having at least one fastener receiving passageway therein offset a predetermined distance from an axis defined by the imaginary cylinder in a direction away from the recess, and

- at least one fastener extending between corresponding fastener receiving passageways of said pair of clamp members for urging said clamp members

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

together to engage the steering tube and thereby secure the bicycle stem to the steering tube;
said body portion, handlebar clamping portion and steering tube clamping portion being integrally formed as a monolithic unit.

24. (Amended) A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:

a body portion having opposing first and second ends;
a handlebar clamping portion connected to the first end of said body portion;

a steering tube clamping portion connected to the second end of said body portion and having a tubular shape defining a steering tube receiving passageway therethrough, said steering tube clamping portion also having a clamp receiving passageway therein transverse to the steering tube receiving passageway and in communication therewith;

a steering tube clamp in the clamp receiving passageway and comprising

a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, each clamp member having a plurality of fastener receiving passageways therein offset a predetermined distance from an axis of the imaginary cylinder, and

a plurality of fasteners extending between corresponding fastener receiving passageways of said

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

pair of clamp members for urging said clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

28. (Amended) A bicycle stem according to Claim 24 wherein [said clamp members also comprise portions defining an imaginary cylinder; and wherein] the fastener receiving passageways are also canted at a predetermined angle from parallel to [an] the axis of the imaginary cylinder.

33. (Amended) A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:

a body portion having opposing first and second ends;

a handlebar clamping portion connected to the first end of said body portion;

a steering tube clamping portion connected to the second end of said body portion and having a tubular shape defining a steering tube receiving passageway therethrough, said steering tube clamping portion also having a clamp receiving passageway therein transverse to the steering tube receiving passageway and in communication therewith;

a steering tube clamp in the clamp receiving passageway and comprising

a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, each clamp member also having at least one fastener receiving passageway

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

therein canted at a predetermined angle from parallel to an axis of the imaginary cylinder, and
at least one fastener extending between corresponding fastener receiving passageways of said pair of clamp members for urging said clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231, on this 3rd day of OCTOBER, 2002.

